

13. In this regard, note the Preliminary Amendment filed on December 18, 1992, whereon dependency on claim 2 was deleted.

Claim 9 is only dependent on claim 15 and claim 10 is dependent on claim 9.

Thus, claims 3, 9 and 10 are not dependent on canceled claims.

With regard to Official Action paragraph 5, claims 14 and 16 have been rejected under 35 U.S.C. §112, first paragraph.

In the last paragraph of this 35 U.S.C. §112, first paragraph objection, the Examiner suggests that present Examples 4 to 8 are speculative, and that the specification is not enabling for anything more complex than the simple starting materials demonstrated in Examples 1 to 3. Applicant takes issue with this. Example 7 describes a protocol for recovering plasmid DNA from bacterial cells. That protocol is entirely sufficient to enable a skilled reader to perform the technique. Assignee of this application, Amersham International plc, currently markets a kit RPN 1688/9 "FMP for plasmid minipreps", for which the protocol is essentially the same as that described in Example 7; a copy of the cover pages of the kit booklet are attached to this response (Attachment A).

Similarly, Example 5 describes the purification of low molecular weight DNA from a starting suspension of bacteriophage. Again, the protocol is completely sufficient for a skilled reader to perform the example. Again, Amersham International plc markets a kit RPN 1690 "Fast Magnetic Purification (FMP) for M13 single-stranded DNA minipreps", of which the protocol is closely based on that described in Example 5. Again, a copy of the cover pages of the kit booklet are attached to this response (Attachment B).

Example 7 provides an enabling disclosure to support claim 14.

Example 5 provides an enabling disclosure to support claim 16.

Accordingly, the present specification is considered to be fully enabling for the presently claimed scope.

Turning to Official Action paragraph 6, claims 3, 9, 10 and 13-18 have been rejected as indefinite in the use of various terms.

With regard to the lack of proper antecedent basis for the term "solution" in claim 13, such term no longer appears.

With regard to the rejected term "impure solution" in claim 14, line 5, such term, in fact, appears on lines 2 and 4 and has been changed to "bacterial lysate".

With regard to the rejected term "suspended magnetically attractable particles" in line 7 of claim 15, such has been changed to "suspended magnetically attractable beads" to be consistent with the remainder of the claim.

With regard to the rejected term "protein", such rejection is not understood and such term appears in other claims such as 14 and 16 wherein no rejection was made.

The term "protein" is, of course, well known to those skilled in the art and it is not apparent why it has been rejected in the context of claim 15.

With regard to claim 16, it has been clarified in several self-explanatory ways, responsive to the Examiner's comments.

The rejections of claim 18 are moot in view of the cancellation thereof.

Claims 13 and 14 have been rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103 as obvious over Lyle. This rejection is respectfully traversed. Lyle describes the use of a polycationic solid support to selectively adsorb nucleotide multimers. It appears that the nucleotides are adsorbed immediately when the support is introduced into the solution. Lyle is unsuggestive of the instant claims which recite a step of precipitating that nucleic acid out of solution in the presence of suspended magnetically


attractable beads, whereby the nucleic acid precipitate becomes non-specifically associated with the beads. Lyle is thus irrelevant to the present claims (as are Warren and Mitchell).

No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, he is invited to contact undersigned at the telephone number below.

Respectfully submitted,

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May 3, 1994